

REMARKS/ARGUMENTS

The claims have now been divided into Groups as follows:

- Group 1: Claims 17-26, drawn to a method for the synthesis aminodihalophosphines, diaminohalophosphines and triaminophosphines.
- Group 2: Claims 17-26, drawn to a method for the synthesis phosphorous ester diamides.
- Group 3: Claims 17-26, drawn to a method for the synthesis aminophosphines and diaminophosphines.
- Group 4: Claims 17-26, drawn to a method for the synthesis phosphorous ester amide halides.
- Group 5: Claims 17-26, drawn to a method for the synthesis aminophosphine halides.
- Group 6: Claims 17-26, drawn to a method for the synthesis phosphonous ester halides.
- Group 7: Claims 27 and 28, drawn to a method of removing acids from reaction mixtures.
- Group 8: Claim 29, drawn to a method of stopping acid-catalyzed reactions.

Applicants elect, with traverse, Group I, Claims 17-26, drawn to a method for the synthesis aminodihalophosphines, diaminohalophosphines and triaminophosphines for examination.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Examiner if restriction is not required (MPEP §803). The burden is on the Examiner to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803).

Moreover, when citing lack of unity of invention in a national stage application, the Examiner

has the burden of explaining why each group lacks unity with each other group specifically describing special technical features in each group (MPEP § 1893.03(d)).

The Office has asserted that Groups 1-8 are:

“independent and patentably distinct because there is no patentable co-action among the eight groups and a reference anticipating one member will not render the other obvious. The eight Groups are directed to different processes that require different reaction conditions. These eight groups are different inventions and require different search strategies.”

Applicants respectfully submit that the above-identified application is a U.S. National application filed under 35 U.S.C. 371. MPEP § 1893.03(d) states:

“Examiners are reminded that unity of invention (not restriction) practice is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371.”

Applicants respectfully submit that Rule 13.1 under Unity of Invention indicates that the inclusion of more than one invention in one international application is only permitted if all inventions are so linked as to form a single general inventive concept.

Applicants respectfully point out that each of the synthesis methods described in Claim 17 share a common character in that all generate acid. Therefore each of the synthesis methods share the common inventive improvement in the step of eliminating the acid formed, as presently described in Claim 17.

Annex B of the Administrative Instructions under the PCT at (b) Technical Relationship states:

“The expression “special technical features” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, considered as a whole, makes over the prior art. The determination is made on the contents of the claims as interpreted in light of the description and drawings (if any).”

Applicants respectfully submit that the Examiner has not provided sufficient indication that the contents of the claims interpreted in light of the description was considered

in making the assertion that the groups are distinct. Moreover, lack of unity has not been established and therefore the burden necessary to support an assertion of lack of unity has not been met.

Moreover, Applicants respectfully submit that the groups are actually related processes as described above and that MPEP §806.05(j) applies.

The MPEP (§806.05(j)) states that related product inventions are distinct if:

- “(A) the inventions *as claimed* do not overlap in scope, i.e., are mutually exclusive;
- (B) the inventions *as claimed* are not obvious variants; and
- (C) the inventions *as claimed* are either not capable of use together or can have a materially different design, mode of operation, function, or effect.”

Applicants respectfully submit that the Office has not demonstrated any of the indications of distinctness (A), (B) or (C) listed in MPEP (§806.05(j)).

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary to establish lack of unity of invention in order to sustain the Restriction Requirement. Withdrawal of the Restriction Requirement is respectfully requested.

Applicants submit that the above-identified application is now in condition for examination on the merits, and early notice of such action is earnestly solicited.

Respectfully submitted,

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